

REMARKS

Claims 1-20 are pending.

Drawings

The indication that the drawings filed on October 28, 2003 were accepted is noted.

Information Disclosure Statement

The indication that the documents on the Information Disclosure Statement of October 28, 2003 have been considered is noted.

Foreign Priority

Foreign priority documents were presented in this application. The Examiner is requested to acknowledge the claim for foreign priority.

Reply to Rejections

First Rejection

Claim 1 was rejected under 35 U.S.C. § 112 for the reasons explained in Section 2 of the Office Action.

To alleviate the concerns of the Examiner, the claim has been amended, and also minor editorial changes have been made to some of the other claims as needed.

It is submitted that claim 1 is now in proper form under 35 U.S.C. § 112, second paragraph.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection under 35 U.S.C. § 112.

Second Rejection

Claims 1 and 2 were rejected under 35 U.S.C. § 102(b) as being anticipated by Tsuruoka (U.S. Patent 4,748,473). This rejection is traversed.

With respect to base claim 1, this claim requires that the one or more paper-separating finger bodies be provided at or near one or more upstream ends in one or more paper transport directions. See, for example, Figure 1 and pages 20 and 21 of the specification. It is submitted that the reference applied does not show either specifically or inherently these features. Also, claim 1 sets forth the positional relationship of the guide member and the support components, which is not shown specifically or inherently in the reference.

Even if it were a possibility or probability that this feature was in the reference, a rejection under 35 U.S.C. § 102 cannot be based on possibility or probability. See *Continental Can Co. USA, Inc. v. Monsanto Co.*, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991), wherein the Court stated as follows:

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled ... [such] that the missing ... matter is necessarily present in the ... reference, and that it would be so recognized by persons of ordinary skill.... “Inherency ... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient”

With respect to claim 2, this claim is considered patentable, at least for the same reasons as its base claim 1.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection under 35 U.S.C. § 102.

Third Rejection

Claims 1-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsuruoka (U. S. Patent 4,748,473) as applied to claims 1 and 2 above in further view of Tsuda et al. (U. S. Patent 4,223,993) and Imaizumi (U. S. Patent 4,065,120). This rejection is traversed.

For the reasons explained above, the base reference does not disclose what has been claimed. The addition of the other references does not cure the innate deficiencies of a rejection based on Tsuruoka.

The positional relationship of the finger bodies, guide members and the support components is now shown or suggested by any one of the three references applied. The positional relationships in the context claimed provide an unexpected result (see paragraph [0012] and [0013] of the specification). Results must be considered in arriving at a conclusion of obviousness. It appears from the Office Action this has not been done. See *The Gillette Co. v. S.C. Johnson & Son, Inc.*, 16 USPQ2d 1923 (Fed. Cir. 1990), which stated as follows:

An analysis of obviousness of a claimed combination must include consideration of the results achieved by that combination. As we explained in *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985) ... [cited in the MPEP].

Also, the Office Action fails to address each and every limitation of the claims. See, for example, claim 9 with respect to the “star-ring-type spurs.” The rejection fails to provide a

prima facie case of obviousness. See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81 (Fed. Cir. 1986), wherein the Court stated as follows:

Focusing on the obviousness of substitutions and differences instead of the invention as a whole ... was a legally improper way to simplify the difficult determination of obviousness.

Also, it is the combination that counts not the elements themselves. See, for example, the case of *Ruben Condenser Co. v. Copelan Refrigeration Corporation*, wherein the Court stated as follows:

We do not of course forget that it is always the combination that counts, and that no patents, or almost none, are made from new elements 85 F.2d 537, 541, 31 USPQ 6, 6 (C.A. 1936).

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 U.S.C. § 103.

Claims 17-20

These claims were not addressed in the Office Action. To date, the Examiner has not acted upon our request of July 6, 2005.

Additional Art Cited

With respect to the additional prior art made of record in the Office Action, since this art has not been applied by the Examiner, no comments are considered necessary.

Conclusion

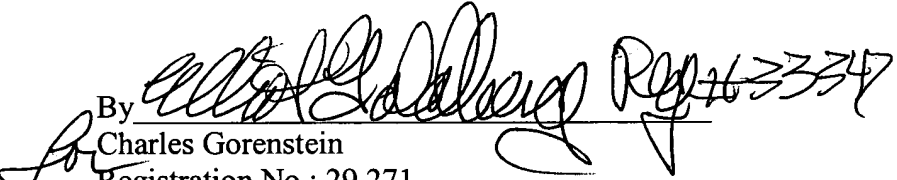
In view of the above amendment, Applicants believe the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Elliot A. Goldberg (Reg. No. 33,347) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: September 7, 2005

Respectfully submitted,

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